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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/746,557	12/22/2000	Bob Haschart	962.011US2	1682

7590

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SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A.

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EXAMINER

MIZRAHI, DIANE D

ART UNIT

PAPER NUMBER

2165

DATE MAILED: 05/31/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/746,557

Applicant(s)

HASCHART ET AL.

Examiner

DIANE D. MIZRAHI

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 126-147 and 158-176 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 126-147 and 158-176 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

DIANE D. MIZRAHI  
PRIMARY PATENT EXAMINER  
TECHNOLOGY CENTER 2100

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III. DETAILED ACTION

Claims 126-147 and 158-176 are presented for examination.

Claims 1-28, 33-42, 59-94, 99-104, 106-108, 111-113, 120-121 and 148-157 need to be canceled by Applicant. These claims have been restricted. Applicant elected claims 126-147 and 158-176 to be examined.

Claim Objections

Claim 136 is objected to because of the following informalities: the appears to be a typographical error on line 2, "136"; Independent Claim 136 cannot depend on claim 136. Did Applicant mean "128"? Appropriate correction is required.

Claim Rejections - 35 USC 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title.

Claims 167-175 are rejected under 35 U.S.C. 101 because the claims are directed to a non-statutory subject matter, specifically, directed towards an abstract idea.

The Supreme Court has repeatedly held that abstractions are not patentable. "An idea of itself is not patentable". Rubber-

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Tip Pencil Co. V. Howard, 20 Wall. 498, 07. Phenomena of nature, though just discovered, mental processes, abstract intellectual concepts are not patentable, as they are the basic tools of scientific and technological work Gottschalk v. Benson, 175 USPQ 673, 675 (S Ct 1972). It is a common place that laws of nature, physical phenomena, and abstract ideas are not patentable subject matter Parker v. Flook, 197 USPQ 193, 201 (S Ct 1978). A process that consists solely of the manipulation of an abstract idea is not concrete or tangible. See In re Warmerdam, 33 F.3d 1354, 1360, 31 USPQ2d 1754, 1759 (Fed. Cir. 1994). See also Schrader, 22 F.3d at 295, 30 USPQ2d at 1459.

Claims 167-175 represent an abstract idea that do not provide a practical application in the technological arts. There is no manipulation of data nor is there any transformation of data from one state to another state being performed in "A method". Actually, no post-computer process activity is found in the technological arts. "A method" is not a physical transformation. Thus, no physical transformation is performed, no practical application is found. Also, the claims do not appear to correspond to a specific machine or manufacture disclosed within the specification and thus encompass any product of the class configured in any manner to perform the underlying process. Consequently, the claims are analyzed based

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upon the underlying process, and are thus rejected as being directed..

Claim Rejections - 35 USC 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 167-175 are rejected under 35 U.S.C. 103(a) as being unpatentable over "Learning lexis.com" (Publication of Lexis Publishing, Dayton, HO (2000), 1-32 and Lexis) in view of Robert L. Heston (Publication. No. 2002/0019741 A1 and Heston hereinafter).

Regarding Claim 143, Lexis teaches a database of legal documents (i.e. with "lexis.com" (page 3); data window for displaying one or more portions ... legal documents.. to legal documents... (page 18) at least one indicator ... (page 5 i.e. (Figure, Look for a legal topic)... first legal document...(page 5, i.e. Figure, Get a document).

Lexis does not expressly teach legal reasoning.

Heston teaches legal reasoning (i.e. questions and respective answers) [0047]

It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to modify the teachings of Lexis with the teachings of Heston to include claimed, "legal reasoning " with the motivation to provide for more efficiency and as a way to interact with a provider of legal services without the delays of handling routine legal matters Heston, [0011].

Regarding Claim 144, Lexis teaches displaying... (page 6, Figures).

Regarding Claim 145, Lexis does not expressly teach color.

Heston teaches color (i.e. which reads on tags in which a tag identifies an element in a document) [0123]-0125].

It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to modify the teachings of Lexis with the teachings of Heston to include claimed, "color" with the motivation to provide for more efficiency and as a way to interact with a provider of legal services without the delays of handling routine legal matters Heston, [0011].

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Regarding Claim 146, Lexis teaches ... citations (i.e. Copyright Cases, Federal) (page 23, Top Figure).

Regarding Claim 147, the limitations of this claim is similar in scope to the rejected claims above and are therefore rejected as set forth above.

Regarding Claims 126-133 and 136, the limitations of these claims is similar in scope to the rejected claims above and are therefore rejected as set forth above.

Regarding Claim 134, the limitations of this claim is similar in scope to the rejected claims above. In addition, Lexis teaches depth-of-treatment indicator (Figure 7).

Regarding Claim 135, Lexis teaches ... subject-matter classifications (page 6, Top Figure).

Regarding Claims 137-142, 158-176 the limitations of these claims is similar in scope to the rejected claims above and are therefore rejected as set forth above.

**Other Prior Art Made of Record**

The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure. U.S. patents and U.S. patent application publications will not be supplied with Office actions. Examiners advises the Applicant that the cited U.S. patents and patent application publications are

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available for download via the Office's PAIR. As an alternate source, all U.S. patents and patent application publications are available on the USPTO web site ([www.uspto.gov](http://www.uspto.gov)), from the Office of Public Records and from commercial sources. For the use of the Office's PAIR system, Applicants may refer to the Electronic Business Center (EBC) at <http://www.uspto.gov/ebc/index.html> or 1-866-217-9197.

#### Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Diane D. Mizrahi whose telephone number is 571-272-4079. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dov Popovici can be reached on (571) 272-4083. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 305-3900 for After Final communications.



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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

A handwritten signature in black ink, appearing to read 'Diane Mizrahi', is written over a horizontal line.

Diane Mizrahi  
Primary Patent Examiner  
Technology Center 2100

May 11, 2005